

### **REMARKS**

This is in response to the Office Action mailed on December 17, 2004, and the references cited therewith.

Claims 16, 19, 20, 22-25, 29, 30, and 32-37 are amended, claims 40-49 are canceled, and no claims are added; as a result, claims 16-39 are now pending in this application.

#### **About the Claim Amendments**

Applicant has amended claim 16 to more clearly point-out the invention and not for reasons of patentability. In particular, Applicant has substituted "including" from the phrase "is comprised of." Additionally, Applicant has added "in a verification computer" to claim 1. Support for this can be found in the Application at pages 6-7.

Applicant has amended claims 19, 22, 23, 24, 29, 30, 32, and 33 to more clearly point-out the invention and not for reasons of patentability. In particular, Applicant has removed the phrase "step of" from these claims.

Applicant has amended claim 16 to more clearly point-out the invention and not for reasons of patentability. In particular, Applicant has substituted "including" from the phrase "is comprised of." Additionally, Applicant has modified the phrase "a user computer" to "the user computer."

#### **§103 Rejection of the Claims**

Claims 16-39 were rejected under 35 USC § 103(a) as being unpatentable over Padgett et al. (U.S. 6,167,518) in view of Ross (U.S. 6,195,447) and in further view of Beetcher et al. (U.S. 5,933,497). Applicant respectfully traverses this rejection because the Office Action has not established a *prima facie* case of obviousness.

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness because the references do not teach or suggest all the claim elements, and even if they did, there is no suggestion or motivation to combine the references.

#### THE REFERENCES DO NOT TEACH OR SUGGEST ALL THE CLAIM ELEMENTS

##### *Discussion of Claim 16*

Claim 16 recites, "receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user." The Office Action admits, "Padgett et al ('518) does not explicitly disclose the features of ... receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user." Office Action mailed 12/17/2004 at page 2 (hereafter referred to as Office Action). However, the Office Action asserts that Ross (column 3, lines 56-59) discloses these claim features. *Id.*

Applicant respectfully submits that the Office Action has mischaracterized Ross. In particular, the cited passage does not mention "a first fingerprint file *and a first identification for the user.*" In contrast, Ross' passage at column 3, lines 56-59 states, "At the local site 40, a processor 42 receives the scanned fingerprint image data from the scanner 32 across the transmission line 26 and acts to locate the real-time discrete topographical minutia points." This passage does not teaches or suggests the claimed "a first fingerprint file *and a first identification for the user.*" Moreover, Applicant cannot find any other passage in Ross that teaches this claim feature.

Claim 16 also recites, "comparing the first fingerprint file against a second fingerprint file, *to verify the user computer.*" (Emphasis added.) The Office Action asserts that Ross discloses this claim feature at column 4, lines 1-7. However, Applicant respectfully submits that the Office Action has again mischaracterized Ross. Ross' passage at column 4, lines 1-14 states,

The processor 42 also connects to a fingerprint database memory 44 to assist in maintaining accurate criteria for subsequent comparison of the real time feature vector to previously detected feature vectors. The processor statistically analyzes the real time feature vector as an individual sample with respect to a history file for the particular fingerprint. The history file is

accessed from the fingerprint database memory and includes statistical criteria comprising mean values of physical relationships between predetermined minutia, or calculated standard deviations between minutia. The file is statistically updated each time the corresponding fingerprint is successfully utilized to gain access to the secured area and is transmitted back to the database memory for storage. (Emphasis added.)

This passage teaches processing a fingerprint to gain access to a secured area. However, the passage does not teach “comparing the first fingerprint file against a second fingerprint file, *to verify the user computer.*” Applicant cannot find any other passages in Ross that teach this claim feature.

Claim 16 also recites, “sending at least one verification response, based upon the comparing of the first fingerprint file against the second fingerprint file and upon the comparing of the first identification for the user against the second identification for the user.” In claim 16, the verification response is based on two comparisons: 1) comparison of the first and second fingerprint files; and 2) comparison of the first and second user identifications. The Office Action asserts Ross teaches these claim features at column 4, lines 25-27. Ross' passage at column 4, lines 25-27 states, “the comparator generates a verification signal for transmission across the transmission line 28 to the access mechanism 34 to admit or deny entry to the secured area.” Although this passage teaches a verification signal, it does not teach or suggest sending a verification response based on comparison of the first and second fingerprint files *and comparison of the first and second user identifications*, as recited in claim 16. Applicant cannot find any other passage in Ross that teaches this claim feature.

For the combination of Padgett, Ross, and Beetcher to teach or suggest all the elements of claim 16, Padgett and Beetcher must teach what Ross is lacking. The Office Action does not point to a passage in Padgett or Beetcher that teaches or suggests the claim features discussed above. As a result, for at least the reasons noted above, Applicant respectfully submits the combination of Padgett, Ross, and Beetcher does not teach or suggest all the elements of independent claim 16.

#### *Discussion of Claims 17-33.*

Claims 17-33 each depend directly or indirectly on independent claims 16. As such, they each include the claim elements discussed above. For at least the reasons noted above, Applicant

respectfully submits that the combination of Padgett, Ross, and Beetcher does not teach or suggest all the elements of dependent claims 17-33.

*Discussion of Claim 34*

Claim 34 recites, “a processor for communicating with the storage unit and the memory unit to compare information indicative of the second fingerprint file and the second identification for the user with information indicative of the first fingerprint file and first identification for the user.” (Emphasis added.) The Office Action asserts Padgett teaches these claim features in the passages at column 2, lines 61-67 and column 3 lines 1-6. Padgett's passage at column 2, line 61 to column 3, line 6 states,

The digital representation of the registrant's biological indicia is encrypted using the registrant's private key and sent to the certificate authority along with the registrant's public key. The certificate authority decrypts the digital representation and stores it. The registrant then visits a remote registration terminal in person with the digital representation and other identifying documents. The operator of the remote registration terminal verifies the identity of the registrant from the identifying documents and transmits the digitized representation to the certificate authority. The certificate authority compares the decrypted digital representation with the representation sent from the remote registration terminal.

This passage describes comparing two items. The certificate authority compares decrypted biological information with information sent from a remote terminal. However, claim 34's processor compares four items. In particular, claim 34's processor is to compare information indicative of the second fingerprint file and the second identification for the user with information indicative of the first fingerprint file and first identification for the user. Therefore, this passage does not teach or suggest the processor of claim 34. Applicant cannot find any other passages in Ross that teach this claim feature.

Claim 34 recites, “a storage unit to store information received from a user computer, the information including a second fingerprint file and a second identification for a user.” (Emphasis added.) Claim 34 also recites, “a memory unit to receive information indicative of a first fingerprint file and a first identification for the user.” The Office Action asserts Ross discloses these claim features at column 3, lines 56-59. Ross' passage at column 3, lines 56-59 states, “At

the local site 40, a processor 42 receives the scanned fingerprint image data from the scanner 32 across the transmission line 26 and acts to locate the real-time discrete topographical minutia points.” This passage clearly does not teach or suggest the claimed storage and memory units. Moreover, Applicant cannot find any other passages in Ross that teaches these claim features.

Claim 34 recites first and second fingerprint files, where each fingerprint file includes at least one identifying characteristic of a user computer. The Office Action admits that Beetcher does not include a second fingerprint file. See Office Action at page 7. However, the Office Action asserts that a second fingerprint file would have been obvious “since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” Office Action at page 7, citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ8. The Office Action’s position assumes the claimed invention has merely added a second fingerprint file to a well-known device. On the contrary, the claimed invention includes a second fingerprint file and a processor for performing operations based on the second fingerprint file. As such, the claimed invention has not merely duplicated the essential working parts of a device, but has created a patentable clearinghouse computer.

*Discussion of Claims 35-39.*

Claims 35-39 each depend directly or indirectly on independent claims 34. As such, they each include the claim elements discussed above vis-à-vis claim 34. For at least the reasons noted above, Applicant respectfully submits that the combination of Padgett, Ross, and Beetcher does not teach or suggest all the elements of dependent claims 35-39.

THERE IS NO SUGGESTION TO COMBINE BEETCHER WITH PADGETT AND ROSS

Beetcher describes techniques for restricting the ability of a computer user to use licensed software in a manner inconsistent with the license (see Beetcher at column 1, lines 7-11), whereas Padgett teaches using biometric information to authenticate electronic messages (see Padgett at column 1, lines 6-11). Ross teaches a system for authenticating human fingerprints. See Ross at Abstract. The Office Action has improperly combined Beetcher with Padgett and Ross. For a proper combination, the Office Action must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead

an individual to combine the relevant teaching of the references. *In re Fine*, F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The *Fine* court stated,

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The Office Action asserts that one of ordinary skill in the art would combine Beetcher with Padgett and Ross "in order to increase security and systems that utilize unique hardware identifiers." Office Action at page 7. However, this assertion is unfounded, as the Office Action does not identify a single passage in any of the references that teaches or suggests combining Beetcher with Padgett and Ross. Because there is no teaching or suggestion to combine the cited references, Applicant submits that the combination is improper. As such, Applicant requests withdrawal of the rejections under 35 USC §103.

#### Official Notice

Applicant objects to the Examiner's taking Official Notice in claims 21, 22, 25, 31, 33, and 39. Applicant respectfully requests that the Examiner provide references supporting the concepts for which Official Notice is taken.

#### Interview Request

Applicant requests a telephone interview with the Examiner before any further action is taken on this case. Applicant's representative, Andrew DeLizio, can be contacted at 612-373-6900.

#### Reservation of Rights

Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art. Applicant also reserves the right to pursue cancelled and

originally filed claims in a continuation application. Furthermore, Applicant does not acquiesce to any of the Examiner's assertions about the claims or the cited references and reserves the right to argue these assertions in the future.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (281) 213-8980 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SANCHO ENRIQUE DAVID

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
408-333-9972

Date 4/13/05

By Andrew DeLizio  
Andrew DeLizio  
Reg. No. 52,806

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: M/S Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of April, 2005.

Dawn R. Shaw  
Name

Dawn R. Shaw  
Signature